

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars:

Objections to the Specification

The Examiner's objections to the specification have been obviated by appropriate amendments in respect to the appropriate use and capitalization of trademarks and trade names. Withdrawal of the objection is respectfully requested. Additional amendments have been made to the specification and to the abstract of the disclosure to improve the language used and to provide literal antecedent basis for the claims as amended. No new matter has been added.

Rejection of claims 1-6 under 35 U.S.C. § 112, second paragraph

Claims 1-6 currently stand rejected as indefinite because of the inclusion of the trademark/trade names CompactFlash, Memory Stick, and Smart Media, these names being referenced in the claims in abbreviated forms CF, MS, and SM. This rejection is respectfully traversed.

The Examiner states that "[w]here a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. § 112, second paragraph", and the Examiner cites Ex Parte Simpson, 218 USPQ 1020 (Bd. App. 1982) for this proposition. However, referring to § 2173.05(u) of the MPEP, "[t]he presence of a trademark or trade name in a claim is not, per se, improper under 35 U.S.C. 112, second paragraph, but the claim should be carefully analyzed to determine how the mark or name is used in the claim."

It is respectfully submitted that the use of the terms CF, MS, and SM are not intended to "identify or describe a particular material or product" as proscribed by Ex

Parte Simpson, but instead are intended to refer to interface specifications associated with the devices, as clearly indicated in the claims by the language “*memory cards of specifications including* those of [CF, MS, SM]” (emphasis added).

A person skilled in the art would understand each of the terms, as used, to refer to a particular specification describing the dimensions and electrical interfacing requirements of each of the respective devices. The Examiner is referred to the patents U.S. 6,738,259, U.S. 6,776,348, U.S. 6,612,492, U.S. 6,751,694, U.S. 6,672,904, U.S. 6,540,523, and the patent application publications US 2003/0098346, US 2002/0065001, US 2002/0178307, and US 2004/0184246, each cited by the Examiner in the present Office Action, which each refer to some or all of the terms CompactFlash, Memory Stick, and Smart Media, and their respective abbreviated forms CF, MS, and SM. It is respectfully submitted that these patent publications stand as evidence that these terms are well known to and understood by those skilled in the art.

Accordingly, withdrawal of the rejection is respectfully requested.

Rejection of claims 1-5 under 35 U.S.C. § 103(a)

Claims 1-5 currently stand rejected as unpatentable over Le et al (US 6,738,259) (“Le”) in view of admitted prior art. This rejection is respectfully traversed for the following reasons.

Le describes an apparatus “that is capable of receiving a number of different types of flash memory cards using a *single slot*” (emphasis added). The present application claims a card reader including *multiple slots* for receiving various types of memory cards. Additionally, the multiple slots are formed in *two separate* connector modules. Claims 1-6 have been amended to clarify this point, reciting now a “first connector module” having a plurality of insertion slots and a “second connector module” also having an insertion slot. The amendments were not made to avoid prior art, as it is believed that the original claims are fully patentable over the cited prior art. Rather, in reviewing the claim

language it was perceived that some of the language could be improved to more clearly define the inventive subject matter.

While the Examiner construes the single slot of Le's device as a plurality of insertion slots because of Le's slot dimensions that accommodate various memory cards within the single slot, this construction fails because a single slot, despite its varied dimensions, is simply not a plurality of slots. The slot 13 of Le's device is referred to, throughout Le's specification, in the singular form, reinforcing the assertion of Le's abstract that the device uses a single slot.

Because Le has only a single slot, Le does not, and cannot, have a first and a second connector module, each having at least one insertion slot. Such an arrangement is neither disclosed nor suggested by Le. In fact, it is respectfully suggested that Le teaches away from the multiple insertion slots and the first and second connector modules that the present application employs to provide the multiple insertion slots, since a fundamental purpose of Le is evidently to provide *a single* insertion slot with compatibility with the multiple types of memory cards. In contrast, the present application makes clear that with the multiple insertion slots, multiple memory cards may be accommodated and accessed simultaneously.

The Examiner contends that, while Le fails to disclose that the card reader is a 7-in-1 card reader and that insertion slots are provided for CF, MD, and XD memory cards, admitted prior art teaches that CF, MD, and XD were old and well known, and therefore the present invention would be obvious in view of Le and admitted prior art. This argument fails because, without reference to the present application, no motivation is found in Le to incorporate the multiple insertion slots or the first and second connector modules of the present invention. This combination can only result from the Examiner's hindsight reading of the prior art in view of the present application, and therefore does not form a valid basis for rejection.

Thus, because Le fails to teach or suggest the presently claimed invention, and because there is no suggestion or motivation to modify Le in a manner to arrive at the

presently claimed invention, it is respectfully submitted that claim 1, and accordingly the dependant claims 2-6, are allowable over the cited art of record, and the withdrawal of the rejection is respectfully requested.

Rejection of claim 6 under 35 U.S.C. § 103(a)

Claim 6 currently stands rejected as unpatentable over Le in view of admitted prior art, and further in view of Pua (US 2002/0178307). This rejection is respectfully traversed for the following reasons. As discussed above, Le in view of admitted prior art fails to teach or suggest all of the limitations of independent claim 1. It is respectfully submitted that Pua fails to supplement the combined teachings of Le and admitted prior art to overcome the shortcomings of the rejection. Therefore, because claim 1 is allowable over the cited art of record, dependant claim 6 also is allowable, and the withdrawal of the rejection is respectfully requested.

Remaining art of record not relied upon to reject any claims

The amended claims have been compared with the remaining art cited by the Examiner and it is respectfully submitted that the claims are patentable over such prior art.

Conclusion

In view of the amendments to the claims, and in further view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is requested that claims 1-6 be allowed and the application be passed to issue.

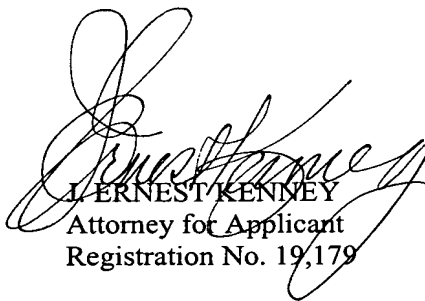
Application No.: 10/656,276  
Examiner: Jared FUREMAN  
Art Unit: 2876

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's attorney, the Examiner is invited to contact the undersigned at the numbers shown.

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Respectfully submitted,



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